

U.S. Patent Application Serial No. 10/798,889  
Response filed April 24, 2008  
Reply to OA dated January 24, 2008

**REMARKS:**

Claims 1 and 4-13 are currently pending. Claims 1, 4, 5, and 8-13 are currently being considered. Claims 6 and 7 have been withdrawn from consideration. Claim 1 has been amended herein for only one reason: to remove informalities.

**A. The Examiner has objected to claims 1, 4, 5, and 8-13 for various noted informalities.**

With reference to claim 1, the Examiner has suggested that the phrase --at least-- should be inserted in particular areas, and has also suggested that the term "workpieces" should be changed to --workpiece-- (see lines 17-18).

In response to this objection, the phrase --at least-- has been inserted in certain areas in claim 1 (see lines 9-17), and the term "workpieces" has been changed to --workpiece-- (see lines 17-18). These amendments to claim 1 were made only to remove informalities.

Accordingly, in view of the above, Applicants respectfully submit that this objection to claim 1 should be withdrawn. It is submitted that this objection to claims 4, 5, and 8-13 should be withdrawn by virtue of their dependency.

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B. The Examiner has rejected claims 1, 4, 5, and 8-13 under the second paragraph of 35 U.S.C. §112 for indefiniteness.

The Examiner has rejected claims 1, 4, 5, and 8-13 under the second paragraph of 35 U.S.C. §112 as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention.

With reference to claim 1, the Examiner has suggested that the text “the second workpiece” has insufficient antecedent basis (see line 13).

In response to this rejection, the word “the” has been changed to --a-- (claim 1, line 13). This amendment to claim 1 was made only to remove an informality.

Accordingly, in view of the above, Applicants respectfully submit that this rejection of claim 1 should be withdrawn. It is submitted that this rejection of claims 4, 5, and 8-13 should be withdrawn by virtue of their dependency.

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C. The Examiner has rejected claims 1, 5, 8, 10, and 12 under 35 U.S.C. §103(a) as obvious over information disclosed on pages 1-3 of the specification of the subject application, in view of U.S. Patent No. 4,660,266 (**Horn '266**) or U.S. Patent No. 3,818,577 (**Bailey '577**) or U.S. Patent 6,666,584 (**Yokota '584**) and U.S. Patent No. 3,510,551 (**McCrea '551**).

Applicants respectfully traverse this rejection, for the following reasons.

There are substantial, important differences between the art relied upon by the Examiner and the features set forth in the claims in issue.

In this rejection under 35 U.S.C. §103(a), the Examiner has relied upon various combinations and modifications of a total of **five** separate references.

The Examiner has suggested that the information disclosed on pages 1-3 of the specification of the subject application corresponds to "Applicant's Admitted Prior Art" or "AAPA." However, the term "prior art" is not used in that portion of the specification. The disclosure in the subject application, from page 1, line 12 to page 3, line 18, shall be referred to herein as "**Related Art**." The phrase "Description of the Related Art" appears on page 1 at line 11.

**Related Art, Horn '266, Bailey '577, Yokota '584, and McCrea '551, alone or in**

combination, fail to describe, teach, or suggest the following features set forth in claim 1: "forming short, cylindrical first workpieces made of the second material and each having a cylindrical inside surface serving as the bearing surface," in combination with the other claimed features.

The Examiner has acknowledged that the **Related Art** does not disclose all features set forth in claim 1 (see the Office Action dated January 24, 2008, page 3, lines 14-18).

**Horn '266, Bailey '577, and Yokota '584** were cited as teaching a method of obtaining two substantially equivalent components by dividing a single previously formed member. These references teach a general concept of obtaining two substantially equivalent components by dividing a single previously formed member or structure. However, all that is taught by these three references is to divide a single member or structure into two substantially equivalent components or structures.

In particular, **Horn '266** does not teach a bearing member but teaches a pipe connector made up of substantially equivalent split members. **Bailey '577** teaches that parts are cast or forged as an integral piece, which is then cut to obtain two parts. These parts are then fastened together. **Yokota '584** teaches a roller bearing cage made of a pair of two semicircular cage halves which are arranged in opposition and assembled together.

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Those three references (**Horn '266, Bailey '577, and Yokota '584**), alone or in combination, fail to describe, teach, or suggest "forming short, cylindrical first workpieces made of the second material and each having a cylindrical inside surface serving as the bearing surface," in combination with the other claimed features.

The **Related Art** fails to remedy the above-described deficiencies of **Horn '266, Bailey '577, and Yokota '584**. The fifth reference cited and relied upon by the Examiner, **McCrea '551**, teaches a casting method for casting a composition article. **McCrea '551** fails to remedy the above-described deficiencies of **Related Art, Horn '266, Bailey '577, and Yokota '584**.

Applicants submit that it would not have been obvious to combine/modify **Related Art, Horn '266, Bailey '577, Yokota '584, and McCrea '551** in order to arrive at the features set forth in **claim 1**.

In view of the above, the Examiner has not yet established a *prima facie* case of obviousness. But it is the burden of the Examiner to do so. The U.S. Patent and Trademark Office has the burden of proof to show that an applicant is not entitled to a patent if the claimed subject matter is anticipated by, or is obvious from, the art of record. A patent applicant is entitled to a patent "unless" the U.S. Patent and Trademark Office establishes otherwise. See, e.g., *In re Dembiczak*,

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175 F.3d 994, 1001 (Fed. Cir. 1999); *In re Epstein*, 32 F.3d 1559, 1564 (Fed. Cir. 1994); *In re Rijckeart*, 9 F.3d 1551, 1552 (Fed. Cir. 1992); *In re Fine*, 837 F.2d 1071, 1074 (Fed. Cir. 1988).

In view of the foregoing, it is respectfully believed that essential elements of a *prima facie* case of obviousness are missing. The above-referenced art, cited and relied upon by the Examiner, does not describe, teach, or suggest the combination of features as set forth in **claim 1**.

Accordingly, Applicants respectfully submit that the Examiner has not established a *prima facie* case regarding **claim 1**.

**Related Art, Horn '266, Bailey '577, Yokota '584, and McCrea '551**, alone or in combination, fail to describe, teach, or suggest the following features set forth in claim 1: "forming short, cylindrical first workpieces made of the second material and each having a cylindrical inside surface serving as the bearing surface," in combination with the other claimed features.

Accordingly, in view of the above, Applicants respectfully submit that this rejection of claim 1 should be withdrawn. It is submitted that this rejection of claims 5, 8, 10, and 12 should be withdrawn by virtue of their dependency.

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D. The Examiner has rejected claim 4 under 35 U.S.C. §103(a) as obvious over **Related Art** in view of U.S. Patent No. 4,660,266 (**Horn '266**) or U.S. Patent No. 3,818,577 (**Bailey '577**) or U.S. Patent 6,666,584 (**Yokota '584**) and U.S. Patent No. 3,510,551 (**McCrea '551**), and further in view of DE 19959540 (**Beyer-Steinhauer '540**).

Applicants respectfully traverse this rejection, for the following reasons.

There are substantial, important differences between the art relied upon by the Examiner and the features set forth in the claims in issue.

In this rejection under 35 U.S.C. §103(a), the Examiner has relied upon various combinations and modifications of a total of **six** separate references.

**Related Art, Horn '266, Bailey '577, Yokota '584, McCrea '551, and Beyer-Steinhauer '540**, alone or in combination, fail to describe, teach, or suggest the following features set forth in claim 1: "forming short, cylindrical first workpieces made of the second material and each having a cylindrical inside surface serving as the bearing surface," in combination with the other claimed features.


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Accordingly, in view of the above, Applicants respectfully submit that this rejection of claim 4 should be withdrawn by virtue of its dependency.

In claim 1, line 12, a spelling correction has been made regarding the term "metallurgically." This amendment was made only to remove an informality.

If, for any reason, it is felt that this application is not now in condition for allowance, the Examiner is requested to contact the Applicants' undersigned attorney at the telephone number indicated below to arrange for an interview to expedite the disposition of this case.

In the event that this paper is not timely filed, the Applicants respectfully petition for an appropriate extension of time. Please charge any fees for such an extension of time and any other fees which may be due with respect to this paper to Deposit Account No. 01-2340.

Respectfully submitted,  
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